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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALAIN T. RAPPAPORT and ELIOT WEITZ

Appeal 2009-004471
Application 09/713,962
Technology Center 3600

Decided:¹ July 6, 2009

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Alain T. Rappaport, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-23. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.²

THE INVENTION

The invention is a method of communicating healthcare information by storing a set of codes corresponding to respective healthcare data in memory of a portable terminal. Specification 4:2-5. After codes are selected, the codes are transmitted wirelessly to a recipient. Specification 4:5-71.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method of communicating healthcare information, the method comprising:

displaying a set of codes each corresponding to respective healthcare data, the healthcare data including a plurality of medical diagnoses each of which corresponds to at least one code;

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Jun. 20, 2008) and Reply Brief ("Reply Br.," filed Oct. 20, 2008), and the Examiner's Answer ("Ans.," mailed Sep. 16, 2008).

storing the set of codes and the medical diagnoses in a memory of a portable terminal;

detecting selection by a user of a subset of the displayed codes that corresponds to a medical diagnosis relevant to a patient; and

wirelessly transmitting the selected subset of the displayed codes from the portable terminal to a server system via a first network capable of providing communication between the portable terminal and the server system, wherein said wirelessly transmitting causes the healthcare data corresponding to the selected subset of the displayed codes to be provided to a medical patient via a second network capable of providing communication between the server system and a patient accessible device.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Lavin	US 5,772,585	Jun. 20, 1988
Montlick	US 5,561,446	Oct. 1, 1996
Gershman	US 6,199,099 B1	Mar. 6, 2001

The following rejection is before us for review:

1. Claims 1-6, 8-10, 12, 13, and 15-23 are rejected under 35 U.S.C. § 103(a) over Montlick, and Lavin.
2. Claims 7, 11, and 14 are rejected under 35 U.S.C. § 103(a) over Montlick, Lavin, and Gershman.

ARGUMENTS

The Appellants traverse the Examiner's rejection of claims 1-23 by asserting that the combination of Montlick, Lavin and Gershman does not teach or suggest all of the features of the claims. App. Br. 5-6. The Appellants' argument is directed to the limitations of independent claim 1 and dependent claim 5. App. Br. 6. The Appellants merely state that independent claims 9, 12, 18, 21, 22, and 23 recites similar features as claim 1 and do not make any arguments regarding dependent claims 2-3, 6-8, 10-11, 13-20. App. Br. 6-8 and Reply Br. 1-4.

First, the Appellants argue that Montlick, Lavin and Gershman do not teach the step of storing the set of codes and the medical diagnoses in a memory of a portable terminal as recited in claim 1. App. Br. 6-8. The Appellants assert that, contrary to the Examiner's rejection, Montlick describes storing patient information in the memory of a central computer and not the memory of a portable terminal as claimed. App. Br. 6. The Appellants also argue that Lavin describes storing a common database which contains the diagnostic information on a server and not on a workstation in an exam room. Reply Br. 3.

The Examiner responds that Montlick at column 5, lines 36-67 and column 6, line 7 teaches this step. Ans. 17-18. However, in the rejection the Examiner contends that Montlick discloses storing the set of codes in column 10, lines 6-30 but does not explicitly disclose having the medical diagnoses in a memory of a portable terminal. Ans. 16. Column 4, lines 33-67 of Lavin was cited to suggest having the medial diagnosis in a memory of a portable terminal. Ans. 17.

Second, the Appellants argue that Lavin does not teach that the step of wirelessly transmitting causes the healthcare data corresponding to the selected subset of the displayed code to be provided to a medical patient via a second network capable of providing communication between the server system and a patient accessible device, as the Examiner contends. App. Br 7. The Appellants assert that Lavin only allows medical practitioners and staff access to diagnoses/procedure information in a database and thus does not teach allowing a patient to access. *Id.*

Third, for the same reasons as above, the Appellants also argue that Lavin does not teach that the claimed recipient is a gateway that connects the first, wireless network to a second network as recited in claim 5. App. Br. 7-8.

The Examiner responds, to Appellants' second and third argument, that Montlick at column 5, lines 1-67 and column 6, line 7 teaches these limitations. Ans. 18.

ISSUES

The issues are:

1. Do independent claims 1, 9, 12, 18, 21, 22, and 23 each require wirelessly transmitting a selected subset of the displayed codes, wherein the wirelessly transmitting causes the healthcare data corresponding to the selected subset of the displayed codes to be provided to a medical patient via a second network capable of providing communication between the server system and a patient accessible device, and if so, would one of ordinary skill

in the art have been led by Montlick and Lavin to this limitation?

2. Do independent claims 1, 9, 12, 18, 21, 22 and 23 each require storing the set of codes and the medical diagnoses in a memory of a portable terminal, and if so, would one of ordinary skill in the art have been led by Montlick and Lavin to this limitation?

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. Claim 1 recites a method including “storing the set of codes and the medical diagnoses in a memory of a portable terminal.”
2. Claim 1 also recites a step of wirelessly transmitting a selected subset of the displayed codes from the portable terminal to a server system via a first network:

wherein the wirelessly transmitting causes the healthcare data corresponding to the selected subset of the displayed codes to be provided to a medical patient via a second network capable of providing communication between the server system and a patient accessible device.
3. Claim 9 recites an apparatus including:

a selector operable by a user to select desired codes of the set of codes for transmission to the server system, the desired codes identifying a

medical condition, wherein transmission of the desired codes causes corresponding healthcare data to be provided to a medical patient via a second network, wherein the second network is adapted to provide communication between the server system and a patient accessible device.

4. Claim 12 recites an apparatus including a portable terminal that includes “a memory associated therewith for storing a set of codes and medical diagnoses.”
5. Claim 18 recites a first server “to communicate the healthcare information to a patient on which diagnosis was performed via a second network, wherein the second network is capable of providing communication between the first server and a patient accessible device.”
6. Claim 21 recites a machine-readable medium comprising instruction which cause the machine to perform operations including wirelessly transmitting the selected subset of codes

wherein the wirelessly transmitting causes the healthcare data corresponding to the selected subset of the displayed codes to be provided to a medical patient via a second network capable of providing communication between the server system and a patient accessible device.
7. Claim 22 recites an apparatus including “a memory that stores a code that respectively correspond to medical diagnoses.”
8. Claim 22 also recites:

a selector that receives selections from a doctor of a subset of the codes in connection with formulating a comprehensive medical diagnosis in

connection with a patient, wherein the apparatus wirelessly transmits the selected subset of codes to a network so that the patient can access the comprehensive medical diagnosis from a remote location.

9. Claim 23 recites a method including “making the medial diagnosis report available to a patient over the Internet.”

The scope and content of the prior art

Montlick

10. Montlick describes a wireless network in an office or hospital that links portable pen-based computers provided to doctors and nurses to a central computer system. Col. 3, l. 60 – col. 4, l. 2.
11. Montlick describes the central computer system having a plurality of digital forms stored in a memory. Col. 4, ll. 61-66.
12. Montlick describes that each portable pen-based computer can retrieve a digitally stored form from the central computer and enter information on the form with a stylus. Col. 4, ll. 1-12 and col. 5, ll. 37-42.
13. Montlick describes one of the forms as a diagnosis form, which includes a list of medical diagnosis and codes. Col. 7, ll. 24-50 and Fig. 2.
14. Montlick describes using the form to enter patient information, including by checking next to a diagnosis on the diagnosis form. Col. 7, ll. 35-41.

15. Montlick states that all of the information entered in the pen-based computer 12 is stored in a patient record file shown in Fig. 7. Col. 10, lines 6-11 and col. 7, ll. 59-63.
16. Montlick states:

The information is transmitted automatically to the central computer system via the wireless network. In the preferred embodiment, this happens when the file or files which locally store the patient information are closed. It may also occur on an automatic periodic basis, so that the central computer system is updated frequently. It may also occur manually, as a “save” function on the pen computer, to assure that the information is available centrally, and is backed up to the central computer system in case of sudden unforeseen problems with the local pen computer.
Col. 7, l. 66 – col. 8, 9.
17. Montlick states that the central computer acts as a gateway. Col. 3, ll. 14-16.
18. Montlick describes the central computer being coupled to the pen-based computer through a wireless local area network. Col. 3, ll. 16-26.
19. Montlick describes the central computer being coupled to other networks through a modem. Col. 5, ll. 6-9.

Lavin

20. Lavin describes a system of managing and processing patient information in a medical clinic. Col. 3, l. 66 – col. 4, l. 5.
21. Lavin describes each workstation having a memory. Col. 4, ll. 40-42.

22. Lavin describes a physician, using a diagnosis list that has codes for various diagnoses, entering a diagnosis into a diagnosis table list on a diagnosis screen at the workstation. Col. 13, ll. 29-46.
23. Lavin describes a custom diagnosis table 308, which is stored in a common database. Col. 4, ll. 19-40, col. 15, ll. 7-10 and Fig. 21.

Gershman

24. Gershman describes using a wireless application protocol for mobile computing. Col. 1, lines 45-60.

Any differences between the claimed subject matter and the prior art

25. Montlick does not explicitly describe the portable pen-based computer storing the diagnosis form, which lists the diagnosis and codes, in memory on the portable pen-based computer after receiving the form from the central computer.
26. Montlick does not describe the wireless transmission of the patient record from the portable pen-based computer to the central computer causes the healthcare data corresponding to the selected subset of the displayed codes to be provided to a medical patient by another network.
27. Lavin does not describe the wireless transmission of the patient record from the portable pen-based computer to the central computer causes the healthcare data corresponding to the selected subset of the displayed codes to be provided to a medical patient by another network.

The level of skill in the art

28. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of selection and transmission

of healthcare information. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (Quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

29. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Obviousness

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1-6, 8-10, 12, 13, and 15-23 under §103(a) as being unpatentable over Montlick and Lavin.

Because the independent claims vary in scope, we will address each independent claim separately though the Appellants arguments only address the limitations of claim 1. Except for claim 5, the Appellants have not argued the dependent claims separately and therefore, the dependent claims will stand or fall with the independent claim from which they depend.

Method Claims 1-6 and 8

Claim 1 recites a method including a step of wirelessly transmitting a selected subset of codes, wherein the transmitting causes the healthcare data corresponding to the selected subset of the displayed codes to be provided to a medical patient. FF 1-2.

In the Answer, the Examiner cites to column 5, lines 1-67 and column 6, line 7 of Montlick to show this feature. Ans. 18. However, in the rejection, the Examiner states that Montlick does not explicitly disclose this feature and cites column 13, lines 29-59 of Lavin. Ans. 4. We find that while the portions of Montlick and Lavin describe wirelessly transmitting a subset of codes from a portable device to a central device (FF 10-13 and 20-23) and that the central computer can be connected to other networks (FF 16), we find that neither Montlick nor Lavin describes the recited transmitting step causing the healthcare data to be provided to a medical patient. FF 26-27. Further, the Examiner has not articulated any apparent reasoning which would lead one of ordinary skill in the art to the invention as claimed and one that is logically underpinned.

Accordingly, we find that the Examiner has failed to establish a prima facie showing of obviousness in rejecting claim 1 and claims 2-6 and 8, dependent thereon.

Apparatus Claims 9-10

First, we find that claim 9 does not require wirelessly transmitting a selected subset of the displayed codes, “wherein said wirelessly transmitting causes the healthcare data corresponding to the selected subset of the displayed codes to be provided to a medical patient via a second network capable of providing communication between the server system and a patient accessible device.” “Many of appellant’s arguments fail from the outset because, . . . they are not based on limitations appearing in the claims” *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

Claim 9 recites an apparatus and not a method like claim 1. FF 3. We construe claim 9 to require a selector that is structured to be *capable* of being operated to select desired codes for transmission that causes the healthcare data to be provided to a patient. We find that Montlick describes the limitation as we have construed it. (FF 12.)

Second, we find that claim 9 does not require storing a set of codes and medical diagnoses in a memory of a portable computer. Claim 9 recites an apparatus that includes a memory, *associated* with the portable terminal. FF 3. The memory is structured to store a set of codes and medical diagnoses. FF 3. We find that Montlick’s description of the memory of the central computer, which stores a diagnosis form, teaches this limitation. FF 11. The memory is associated with portable terminal since the portable terminal sends and receives the forms stored in the memory. FF 12.

Accordingly, we find that the Appellants have not shown that the Examiner erred in rejecting claim 9 and claim 10, dependent thereon.

Apparatus Claim 12-13 and 15-17

First, we find that claim 12 does not require wirelessly transmitting a selected subset of the displayed codes, “wherein said wirelessly transmitting causes the healthcare data corresponding to the selected subset of the displayed codes to be provided to a medical patient via a second network capable of providing communication between the server system and a patient accessible device. “Many of appellant’s arguments fail from the outset because, . . . they are not based on limitations appearing in the claims” *In re Self*, 671 at 1348.

Second, we find that claim 12 does not require storing a set of codes and medical diagnoses in a memory of a portable computer. FF 4. Like claim 9, claim 12 recites an apparatus including a memory that is *associated* with the portable terminal. We find that Montlick’s description of the memory of the central computer, which stores a diagnosis form, meets this limitation. FF 11. The memory is associated with portable terminal since the portable terminal sends and receives the forms stored in the memory. FF 12.

Accordingly, we find that the Appellants have not shown that the Examiner erred in rejecting claim 12 and claims 13 and 15-17, dependent thereon.

Apparatus Claims 18-20

We find that claim 18 does not require either of the limitations argued by the Appellants. “Many of appellant’s arguments fail from the outset because, . . . they are not based on limitations appearing in the claims” *In re Self*, 671 F.2d at 1348. Claim 18 does recite a system comprising a first server to communicate to a patient via a second network, wherein the second network is capable of providing communication between the first

server and a patient accessible device. FF 5. We find that Montlick's description of connecting the central computer to other wireless networks teaches this limitation. FF 16.

Accordingly, we find that the Appellants have not shown that the Examiner erred in rejecting claim 18 and claims 19 and 20, dependent thereon.

Article Claim 21

Claim 21 recites a machine readable medium comprising instructions that cause a machine to wirelessly transmit a selected subset of codes, wherein the transmitting causes the healthcare data corresponding to the selected subset of the displayed codes to be provided to a medical patient. FF 6.

Like for claim 1 above, we find that while Montlick and Lavin describe wirelessly transmitting a subset of codes from a portable device to a central device (FF 10-13 and 20-23) and that the central computer can be connected to other networks (FF 16), we find that neither Montlick nor Lavin describes a machine readable medium comprising instructions that causes a machine to transmit a selected subset of codes which causes the healthcare data to be provided to a medical patient. FF 26-27. Further, the Examiner has not articulated any apparent reasoning which would lead one of ordinary skill in the art to the invention as claimed and one that is logically underpinned.

Accordingly, we find that the Examiner has failed to establish a prima facie showing of obviousness in rejecting claim 21.

Apparatus Claim 22

First, we find that while claim 22 recites an apparatus which includes a memory like claim 1, claim 22 does not require the memory to be the memory of the portable terminal. FF 7. We find that Montlick's description of a central computer storing a diagnosis form in its memory meets this limitation. FF 13.

Second, we find that unlike claim 1, which recites a method, claim 22 recites an apparatus. FF 8. Claim 22 requires that the apparatus be *capable* of transmitting the selected subset of codes to a network so that the patient can access the comprehensive medical diagnosis from a remote location. We find that Montlick's description of connecting the central computer to other wireless networks teaches this limitation. FF 16.

Therefore, we find that the Appellants have not shown that the Examiner erred in rejecting claim 22 under 35 U.S.C. § 103(a) over Montlick and Lavin.

Method Claim 23

First, we find that the method of claim 23 does not recite the storing step as recited in claim 1, which the Appellants argue is not found in Montlick and Lavin. "Many of appellant's arguments fail from the outset because, . . . they are not based on limitations appearing in the claims" *In re Self*, 671 F.2d at 1348.

Second, we also find that claim 23 does not recite the step of causing the healthcare data to be provided to a medical patient in claim 1, which the Appellants argue. Claim 23 does recite a step of making the medical diagnosis report available to a patient over the Internet. FF 9. However, we find this step broader than the step recited in claim 1 and argued by the

Appellants as it requires that the data only be made available instead of causing the data to be provided. Montlick's description of connecting the central computer to other wireless networks teaches this limitation. FF 16.

Therefore, we find that the Appellants have not shown that the Examiner erred in rejecting claim 23 under 35 U.S.C. § 103(a) over Montlick and Lavin.

The rejection of claims 7, 11, and 14 under 35 U.S.C. § 103(a) over Montlick, Lavin, and Gershman.

The Appellants have not argued claims 7, 11, and 14 separately, and, therefore, these claims stand and fall with the independent claim from which they depend. Accordingly, the rejection of claim 7 is reversed and the rejection of claims 11 and 14 are affirmed.

CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 1-6, 8, and 21 and have not shown that the Examiner erred in rejecting claims 9, 10, 12, 13, 15-20, 22, and 23 under 35 U.S.C. § 103(a) over Montlick and Lavin.

Further, we conclude that the Appellants have shown that the Examiner erred in rejecting claim 7 and have not shown that the Examiner erred in rejecting claims 11 and 14 under 35 U.S.C. § 103(a) over Montlick, Lavin, and Gershman.

DECISION

The decision of the Examiner to reject claims 1-8 and 21 is reversed and to reject claims 9-20, 22, and 23 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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